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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/532,995	11/18/2005	Kiyoshi Yagi	Q87740	9113
65565	7590	03/03/2011		
SUGHRUE-265550			EXAMINER	
2100 PENNSYLVANIA AVE. NW			NERANGIS, VICKIE MARIE	
WASHINGTON, DC 20037-3213				
ART UNIT		PAPER NUMBER		
1762				
NOTIFICATION DATE		DELIVERY MODE		
03/03/2011		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/532,995

Applicant(s)

YAGI ET AL.

Examiner

Vickey Nerangis

Art Unit

1762

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-940)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/3/2010 has been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.
3. All outstanding rejections are withdrawn in light of applicant's amendment filed on 12/3/2010.

Claim Rejections - 35 USC § 103

4. Claims 1 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ittel (US 2005/0058822) in view of Metzemacher (US 5,827,906).

Ittel discloses a fiber-reinforce thermoplastic matrix comprising a polyolefin-containing thermoplastic matrix, synthetic fiber such as polyamide and nylon fibers, and silica (claims 1, 3, and 5). The composition is used to prepare an article such as electrical casing (claim 21).

Ittel fails to disclose the use of magnesium hydroxide in the composition, however, it is open to the use of other additives such as flame retardants (paragraph 0061).

Metzemacher discloses a composition for use with cable (col. 1, line 25) comprising magnesium hydroxide surface), polymer such as thermoplastic olefins (col. 10, line 44), and

optionally polyamide fibers (col. 3, line 55), wherein the magnesium hydroxide is used to impart flame retardance to polyolefin composition.

Given that Ittel is open to the use of a flame retardant and further given that Metzemacher teaches that magnesium hydroxide is advantageously and successfully added to polyolefin compositions containing polyamide fiber in order to impart flame retardance, it would have been obvious to one of ordinary skill in the art to add magnesium hydroxide to the composition of Ittel.

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15. The effective 35 USC 102(e) date of Ittel is 8/4/2006 which is the provisional application filing date. Provisional application 60/491,714 supports the portions of the disclosure upon which the examiner has relied.

5. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP '570 (JP 11-106570, full English-language translation) in view of Metzemacher (US 5,827,906).

JP '570 discloses a resin composition comprising a polyolefin-polyamide resin composition that is mixed with rubber or resin as reinforcement (paragraph 0001), wherein the polyolefin-polyamide resin composition comprises 90-40 parts by weight (pbw) polyolefin, 10-60 pbw polyamide fibers having an average fiber diameter of 1 micron or less and an aspect ratio of 20-1,000, and 0.1-5.5 pbw per 100 pbw, per total of polyolefin and polyamide, silane coupling agent (abstract). Note Table 2 which has the polyolefin-polyamide resin composition mixed with NBR (nitrile butadiene rubber) or PE (polyethylene).

JP '527 fails to disclose the use of magnesium hydroxide in the composition, however, it is open to the use of other additives such as fillers (paragraph 0025).

Metzemacher discloses a composition comprising thermoplastic polyolefins, polyamide fibers, and magnesium hydroxide (see discussion in paragraph 5 above), wherein the magnesium hydroxide is used to impart flame retardance to polyolefin composition.

Given that JP '527 is open to the use of additives and further given that Metzemacher teaches that magnesium hydroxide is advantageously and successfully added to polyolefin compositions containing polyamide fiber in order to impart flame retardance, it would have been obvious to one of ordinary skill in the art to add magnesium hydroxide to the composition of JP '570.

6. Claims 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP '570 (JP 11-106570, full English-language translation) in view of Metzemacher (US 5,827,906) and further in view of JP '464 (JP 11-302464).

The discussion with respect to JP '570 and Metzemacher in paragraph 5 above is incorporated here by reference.

JP '570 discloses the use of a filler such as "white carbon," but fails to exemplify or teach the use of silica.

Sugiyama et al teaches that silica is also known as "white carbon" (col. 2, lines 26-27).

Given that JP '570 teaches the use of a white carbon filler which is equivalent to silica as taught by Sugiyama et al, it would have been obvious to one of ordinary skill in the art utilize silica in the polyolefin-polyamide resin composition taught by JP '570.

7. Claims 1, 2, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP '464 (JP 11-302464, machine translation) in view of JP '963 (JP 2000-344963).

JP '464 discloses a resin composition for use in electric wire (paragraph 0001) comprising 90-99 wt % polyolefin and 1-10 wt % polyamide fiber having an average fiber diameter of 1 micron or less and an aspect ratio of 20-1,000 (paragraph 0017), and silane coupling agent (abstract).

JP '527 fails to disclose the use of magnesium hydroxide in the composition, however, it is open to the use of other additives such as fillers (paragraph 0026).

JP '963 discloses a polyolefin resin composition for use in a sheath of electric wires and teaches that flame-retardant inorganic particles such as magnesium hydroxide is useful (abstract).

Given that JP '527 discloses a composition suitable for use in electric wire that is open to other additives such as fillers and further given that JP '963 teaches polyolefin composition for use as sheath of electric wires advantageously includes magnesium hydroxide as flame retardant, it would have been obvious to one of ordinary skill in the art to utilize magnesium hydroxide in the resin composition of JP '464.

8. Claims 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP '464 (JP 11/302464, machine translation) in view of JP '963 (JP 2000-344963) and further in view of JP Sugiyama (US 4,082,909).

The discussion with respect to JP '464 and JP '963 in paragraph 7 above is incorporated here by reference.

JP '464 discloses the use of a filler such as "white carbon" (paragraph 0026) but fails to exemplify or teach the use of silica.

Sugiyama et al teaches that silica is also known as "white carbon" (col. 2, lines 26-27).

Given that JP '464 teaches the use of a white carbon filler which is equivalent to silica as taught by Sugiyama et al, it would have been obvious to one of ordinary skill in the art utilize silica in the composition taught by JP '464 and JP '963.

Response to Arguments

9. Applicant's arguments filed 12/3/2010 have been fully considered but they are not persuasive. Specifically, applicant argues that the present invention provides for unexpected results with respect to dye-colorability, wear resistance, and flame retardancy.

The data in the specification as originally filed has been fully considered, however, it is insufficient to establish unexpected results because the data is not reasonably commensurate in scope with the scope of the claims. Case law holds that evidence is insufficient to rebut a prima facie case if not commensurate in scope with the claimed invention. In re Grasselli, 713 F.2d 731, 741, 218 USPQ 769, 777 (Fed. Cir. 1983). Specifically, the inventive examples only utilize low-density polyethylene (LDPE) as the polyolefin and ultrafine polyamide fiber in only one amount. Also, the amount of magnesium hydroxide and/or silica is only 10-60 parts by weight per 100 parts by weight of LDPE. Case law holds that whether the unexpected results are the result of unexpectedly improved results or a property not taught by the prior art, the "objective evidence of nonobviousness must be commensurate in scope with the claims which the evidence is offered to support." In other words, the showing of unexpected results must be reviewed to

see if the results occur over the entire claimed range (i.e., scope). In re Clemens, 622 F.2d 1029, 1036, 206 USPQ 289, 296 (CCPA 1980), MPEP 716.02(d).

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickey Nerangis whose telephone number is (571) 272-2701. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

vn

/Vickey Nerangis/
Primary Examiner, Art Unit 1762